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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,839	01/09/2001	Robert K. Tendler	TT-115	6881
7590	02/07/2005		EXAMINER	
Robert K. Tendler 65 Atlantic Avenue Boston, MA 02110			NGUYEN, TU X	
			ART UNIT	PAPER NUMBER
			2684	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/756,839

Applicant(s)

TENDLER, ROBERT K.

Examiner

Tu X Nguyen

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's arguments filed 10/13/04 have been fully considered but they are not persuasive.

Applicants argue that "In point of fact, the reason that the inventor came up with the subject invention is his company's inability to redesign the coding for each and every phone model for each and every manufacturer, which one could have a universal GPS module that could interface universally to all phones. If anything, Janky teaches away from the subject invention because he teaches that he must design the I/O of the GPS module for whatever phone bus structure he wants to attach it to. Janky in no way is designing a universal system for configuring a GPS module to any phone, but rather designing for a specific phone. In point of fact, he knows what phone he wants to design to because he specifically configures the packaging of the module to match that of the phone. On the other hand, with the subject invention, one would not perform this physical or electrical matching ahead of time. Thus what the claimed invention accomplishes is the ability to take two intransigent communications systems that are not to be touched and interfaces them in such a way that one can couple the GPS module to any phone by merely reconfiguring a compiler". Janky discloses a designing a universal system for configuring a GPS phone module to any phone (see col.5 lines 30-35).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11 and 13, are rejected under 35 U.S.C. 102(b) as being anticipated by Janky (US Patent 5,786,789).

Regarding claims 1 and 4, Janky discloses a method for the control of an existing wireless phone from an universal output comprising steps of:

interposing a compiler for taking signals in one format and reconfiguring them to a format compatible with the wireless phone, said compiler being between the module and the phone, the compiler (microprocessors 78, 86 inherently have compile command control between GPS device and mobile device) reconfiguring the output of the module to signal which can control the functions of the phone (see col.5 lines 30-35 and col.6 lines 57-66); and

applying the reconfigured output to the phone, such that a universal module output having a pre-selected format is adapted to control the phone which also has a pre-selected format without modification of input/output of the existing phone or modification of the module, thus to adapt the module to control any existing phone (see col.4 lines 55-57, see col.5 lines 30-36, "suitable format" and "actual coding of the commands to be transferred over the control bus" reads on "pre-selected format without modification of input/output").

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Regarding claims 2 and 5, Janky discloses the exiting phone has a bus structure and wherein the compiler compiles the module output to a format compatible with the bus structure of the phone (see col.4 lines 55-60).

Regarding claim 3, Janky discloses the phone has a keypad, wherein the compiler compiles the module output into switch closure signals and wherein the reconfigured output applying step includes the step of providing the switch closure signals to the individual keys of the keypad to control the phone (see col.7 lines 4-40).

Regarding claims 6 and 11, Janky discloses said phone has a data port (see col.7 lines 30-40).

Regarding claim 7, Jankey discloses said phone has a keypad with individual keys switches an wherein said circuit includes at least one conductor connected to one side of a key switch, a signal on said conductor effectuating closure of the corresponding key switch, whereby phone control from said module is accomplished through switch closing of the switches of said keypad, no access to the bus structure of said existing phone being necessary (see col.7 lines 4-40).

Regarding claims 8 and 13, Janky discloses said module includes a GPS receiver (30), wherein said module has an output the location determining by said GPS-receiver and wherein said location output is concerted by said compiler to a predetermined modulation scheme for said phone to permit location reporting form said phone (see col.4 lines 7-20).

Regarding claims 9-10, Janky discloses said modulation scheme includes DTMF tones and whrein said compiler outputs signals to said phone for causing generation of

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said DTMF tones, said DTMF tones reporting corresponding location as determined by said GPS receiver (see col.4 lines 21-39), "dialing" reads on "DTMF tones".

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Janky.

Regarding claim 12, Janky fails to disclose the mobile identification number of said phone. Official notice is taken that the concept of mobile identification number are well known in the art. It would have been obvious each of mobile has identification number itself is made by the unique assigned number associated with mobile device in order to communicate with wireless network.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Janky and further in view of Rodal et al. (US Patent 5,594,453).

Regarding claim 14, Janky fails to disclose GPS information includes time-since-last fix.

Rodal et al. disclose GPS information includes time-since-last fix (see col.9 lines 9-15). Therefore, It would have been obvious to one of ordinary skill in the art at the

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time the invention was made to modify the system of Janky with the above teaching of Rodal et al. in order to provide rapid position acquisition of the GPS receiver.

### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed Tu Nguyen whose telephone number is 703-305-3427. The examiner can normally be reached on Monday through Friday from 8:30AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MAUNG NAY A, can be reached at (703) 308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

### **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

TN

February 1, 2005

  
**NICK CORSARO**  
**PRIMARY EXAMINER**